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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/23/2001

Michael Meiresonne

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1287

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09/13/2006

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EXAMINER

NGUYEN, MERILYN P

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,163

Applicant(s)

MEIRESONNE, MICHAEL

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-54 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: Detailed Action.

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DETAILED ACTION

1. In response to the petition filed 02/15/2006, claims 1-54 are pending in this office action.
2. Application No. 10/421268 filed on April 23, 2003 is a continuation in part of this application.

Remarks

3. This is a response to the petition filed 02/15/2006 via facsimile. The petition is hereby treated as a letter request for reconsideration to withdraw the finality of the 02/08/2006 Office Action. The Finality is hereby withdrawn with the same grounds of rejection previously set forth. The rejection is hereby repeated.

Abstract

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.** (Emphasis added).

The Abstract is objected to because it comprises the phrase, which can be implied, "the present invention includes".

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 19, 22, 24, 36, 49, 51 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8 and 15 of copending Application No. 10/421,268. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the similar limitations.

Claims 1, 8, and 15 of '268 recite broader version of claim 19 of the instant application.

Claims 1, 8, and 15 of '268 contain(s) every element of claims 1-3, 22, 24, 36, 49, 51 and 53 of the instant application and thus anticipate the claims of the instant application. Claims of the instant application therefore are not patently distinct from the '268 and as such are unpatentable over obvious-type double patenting.

<u>10/421,268</u>	<u>Instant Application</u>
Claims: 8 corresponding to	1+2+3
1,8, 15	19, 22, 24, 36, 49, 51 and 53

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 11, 19, 22, 24, 49, 51 and 53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96),¹ In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQZd 1600, 1603-06 (Fed. Cir. 1993)34. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQZd at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a

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word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

In the present case, claimed invention (claim 1, 11, 51, and 53) only recites an abstract idea and does not produce practical application. The recited limitations only describe the idea of how to identify a supplier of goods or services over the Internet.

In the present case, claimed invention (Claims 1, 11, 19, 22, 24, 36, 49, 51 and 53) does not produce tangible result since it recites an abstract idea, which no physical transformation is involved.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 28, 29, 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 28, 29, 40 and 41, the recitation of “at least partially visible” renders the claims vague and indefinite because it does not provide standard for ascertaining the requisite degree.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6, 8-17, 24-34, 36-46, and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rebane (US 6,662,192), in view of Fenton (US 2002/0194151).

Regarding claims 1 and 11, Rebane discloses a method to identify a supplier of goods or services over the Internet comprising:

providing a home page/index page (“infomediary website”, Fig. 17) for a user having at least one link (PDAs link) to a directory Web site (Fig. 18) for a class of goods or services

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having a directory Web site address ("bizrate.com") at least partially descriptive of the class of goods or services (Fig. 18, rating suppliers giving best PDAs products) wherein said directory Web site contains a supplier link to a corresponding supplier's Web site (See Fig. 18, and col. 32, lines 13-31, wherein ecost.com is a supplier link), wherein the home page and the directory Web sites are configured to allow a user to access the homepage (See col. 32, lines 13-31); select a user determined directory Web site based at least in part on the directory Web site address and activate the user determined directory Web site link corresponding to the directory Web site selected by the user link to the selected directory Web site and select the supplier link for a supplier of the class of goods or services (See page 32, line 57 to page 33, line 67).

Rebane further discloses activate the first user determined supplier link to the corresponding user selected first supplier link, thereby launching a first supplier internet browser window and displaying the supplier Web site in the first supplier internet browser window and wherein the supplier offers goods or services of the class of goods or services at least partially described by the directory Web site address (See Fig. 20 and corresponding text, wherein the supplier offers goods or services of the class of goods or service based on the rating of the directory web site) as per claim 11.

Rebane does not explicitly teach a rollover window wherein the rollover window conveys information about a supplier corresponding to the supplier link when the user's cursor is placed substantially over the supplier link. On the other hand, Fenton teach a rollover window (See [0109], Fenton et al.). Because Fenton system use to index websites' content, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate a rollover window into the website of Rebane as suggested by Fenton. Fenton

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teaches rollover display box 838 describing the content item or provide other information to the user about the content item when the user rolls over the content item (See [0109], lines 4-7, Fenton et al.). Although the rollover display box 838 describes information related to multimedia, one having ordinary skill in the art would have recognized that written description in rollover display box can be a description of the supplier's goods or services; therefore, incorporating the rollover display box into the system of Rebane to display information about the supplier's goods or services, thus is well known and intended use. The motivation would have been providing useful information about suppliers to user so that user can decide whether to make further move.

Regarding claims 2 and 13, Rebane/Fenton discloses the directory Web site further comprises a first paragraph of text comprising a description of the class of goods or services ("Home>Computer Hardware&Software>PDAs", Fig. 18, Rebane).

Regarding claims 3 and 14, Rebane/Fenton discloses wherein the directory Web site further comprises a descriptive title portion substantially corresponding to the description of the class of goods or services described by the directory Web site domain name (Top BizRater PDA, Fig. 18, Rebane).

Regarding claims 4 and 15, Rebane/Fenton discloses wherein the directory Web site further comprises a link to the home page (home, Fig. 20).

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Regarding claims 5, 6, 16, and 17, Rebane/Fenton discloses the directory Web site further comprises a supplier descriptive portion corresponding to the supplier, wherein the supplier descriptive portion is located substantially adjacent the corresponding supplier link (See Fig. 18, “3% rebate” is a supplier descriptive portion of Outpost.com).

Regarding claims 8-10, Rebane/Fenton discloses wherein the rollover window conveys information visually/audibly to the user and utilizes a script (See [0039], [0090], Fenton et al.).

Regarding claim 12, Rebane/Fenton discloses selecting a subsequent user determined supplier link for a subsequent supplier of goods or services; and activating the subsequent user determined supplier link to the corresponding user selected subsequent supplier Web site thereby launching a second supplier Internet browser window and displaying the subsequent supplier Web site in the second supplier internet browser window (See Fig. 20, Rebane).

Regarding claims 24-25, 36-37 and 48, these claims contain all the claimed subject matter as set forth above in claims 1, 3, and 6, thus rejected as the same.

Regarding claims 26-27, and 38-39, Rebane/Fenton discloses wherein the directory web site comprises a first set of supplier links and a second set of supplier links (See Fig. 20, Rebane).

Regarding claims 28-29, and 40-41, Rebane/Fenton discloses wherein the first rollover window is substantially visible when the first set of supplier links is substantially visible (See [0090], Fenton et al.).

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Regarding claims 30, 33-34, 42, and 45-46, Rebane/Fenton discloses wherein the directory Web site comprises a second rollover window (See [0090], [0109], Fenton et al.).

Regarding claims 31-32 and 43-44, Rebane/Fenton discloses a plurality of directory Web sites (See Fig. 18, Rebane), wherein each directory Web site contains at least one link to at least other directory Web site (See Fig. 18 and 20, Rebane).

Regarding claims 49, 51, and 53, these claims contain all the claimed subject matter as set forth above in claims 24, and further discloses access a convention search engine; input a search strategy into the conventional search engine to search for a supplier of a user determined good or service; view ranked result links as analyzed by the conventional search engine's algorithm and displayed by the conventional search engine; and activate a ranked result link corresponding to the directory web site corresponding to the user inputted search strategy thereby allowing the user to access the directory web site corresponding to the user inputted search strategy. Please see col. 31, line 62 to col. 32, line 12, Rebane.

Regarding claims 50, 52, and 54, Rebane/Fenton discloses wherein the directory Web site further comprises a related directory Web site link (See Figs. 18 and 20, Rebane et al.).

11. Claims 7, 18-23, 35, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rebane (US 6,662,192), in view of Fenton (US 2002/0194151), and further in view of Perkes (US 2002/0194601).

Regarding claims 7, 18, 35, and 47, Rebane/Fenton discloses all the claimed subject matter as set forth above, however Rebane/Fenton is silent as to wherein the directory Web site comprises at least one substantially descriptive metatag. On the other hand, Perkes teach

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descriptive metatag (See [0042], Perkes et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include descriptive metatag into the directory Web site of Rebane/Fenton. The motivation would have been to cover all possible related searches and increase the ranking archived as suggested by Perkes.

Regarding claim 22, this claim contains all the claimed subject matter as set forth above in claims 1, 3, 6, and 7, thus rejected as the same.

Regarding claims 19-21, this claim contains all the claimed subject matter as set forth above in claims 22 and 49, thus rejected as the same.

Regarding claim 23, Rebane/Fenton/Perkes discloses wherein the rollover window utilizes a script (See [0039], [0090], Fenton et al.).

Response to Arguments

12. Applicant's arguments filed on 10/19/2005 with respect to claims 1-54 have been considered but they are not persuasive.

In response to applicant's argument, to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, it would have been obvious to one having ordinary skill in the art to modify the teachings of Rebane patent to include a rollover window as shown in Fenton. Rebane system collects, evaluates, presents data, and generates information relating to electronic commerce such as rating different merchandises suppliers so that the users can compare and decide which supplier would provide best goods or services. Figure 18 shows various ratings of suppliers of goods or services and various links to suppliers' web sites. For example, when user clicks on "Ecost.com" link of Figure 18, user is directed to that website (Fig. 20). Information about the supplier can be found when the user choose to click on the link "why eCost.com" (Fig. 20). Since the information about the suppliers of Rebane system can be found at each individual supplier's website, therefore, one having ordinary skill in the art would have been modified the teaching of Rebane to include a rollover window as shown in Fenton so that the information about the suppliers can be displayed directly on a rollover window of directory Web site of Fig. 18 of Rebane. Thus, it is obvious to combine the Fenton rollover display box with the Rebane patent. "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art." *In re Keller, Terry, and Davies*, 208

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USPQ 871 (CCPA 1981).

Applicant argues that Rebane does not disclose the amended limitation of a web site where selecting the supplier link for a supplier who offers goods or services of the class of goods or services at least partially described by the directory Web site address or where the supplier's goods or services relate to the class of goods or services. The examiner respectfully point out that this limitation is corresponded to Fig. 20 and corresponding text, wherein the supplier offers goods or services of the class of goods or service based on the rating of the directory web site.

Conclusion

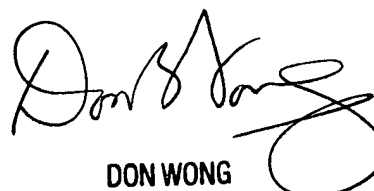
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Marilyn Nguyen
August 08, 2006



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100